

## REMARKS/ARGUMENTS

Reconsideration is respectfully requested of the Office Action of March 22, 2006 relating to the above-identified application.

Claims 1-6 and 9 stand rejected under 35 U.S.C. § 103(a) as obvious with respect to U.S. Patent No. 6,499,485 to *Pepera* in view of U.S. Patent No. 5,531,666 to *Hung*. Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the previously applied prior art in view of U.S. Patent No. 4,745,909 to *Pelton* and U.S. Patent No. 5,693,624 to *Hardy*. Claims 3 and 9 have been cancelled from the present application, and new claim 10 has been added. Arguments concerning the patentability of the rejected claims follow.

### Claims 1, 2 and 4-6

The rejection of claims 1, 2, and 4-6 under 35 U.S.C. 103(a) as being unpatentable over *Pepera* in view of *Hung* is respectfully traversed. *Pepera* and *Hung* accomplish their massaging of a user in materially different ways. *Pepera* utilizes a therapeutic device having an hour glass shaped outer surface with a smooth concave work surface that allows the user to apply a continuous pressure to portions of the user's foot. *See* col. 6, lines 1-17. There are no protuberances that extend from the smooth, curved outer surface of shell of *Pepera*; rather, the outer surface itself is used to engage the user's foot with an arched working surface **30, 32, 34, 130, 132** or **134**. that is, the *Pepera* device is rolled back and forth by a user's foot on a planar surface while the user engages one of the smooth flat surfaces or smooth arched surfaces to loosen and stretch the regions of the foot. Accordingly, there would be no motivation to modify *Pepera* to include protuberances to disrupt the smooth massaging motion taught by *Pepera*.

In contrast, *Hung* describes an egg-like massage device **10** having two towels **20, 30** that engage respective ends of the massage device, with the towels allowing the user to roll the

device over his body to provide a kneading massage effect. *See* col. 1, lines 26-39. In particular, the egg-like device has two compartments **11**, **16** with a hole **12** defined in each end for the towels to extend through. Thus, there is no teaching in *Hung* to permanently include any temperature-controlling substance within the central area of the compartments. To the contrary, any such substance included in *Hung* would immediately be poured out from the compartments through the holes that are engaged by the towels once a person began using the device.

The PTO has the burden under § 103 of presenting a *prima facie* case, and can satisfy this burden by showing that the objective teachings in the prior art would lead one of skill in the art to combine the relevant teachings of the references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598-99 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, the following three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references must teach or suggest all of the limitations of the claims. *See* M.P.E.P. § 2142. In making this determination, the Examiner “must put aside” knowledge of the Applicant’s disclosure, and the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure. *Id.*

There is no motivation to combine *Pepera* with *Hung* to achieve the invention defined in claim 1. Rather, the combination of the two designs would result in a failed device that does not meet any of the desired requirements set forth in either of the references. That is, the inclusion of protuberances in *Pepera* would result in the obliteration of the surfaces specifically used to gently engage the arch of the user’s foot to relieve the plantar fascia. Contrastingly, to seal the

ends of *Hung* to receive the temperature-controlling substance in its central core would destroy *Hung's* use of towels to control the device; otherwise, the central core would not contain the substance. Thus, there is no motivation to combine the references, and the Examiner cannot “pick and choose among the individual elements of assorted prior art references to recreate the claimed invention.” *Id.* at 1600. To achieve the present invention as defined in claim 1, the Examiner would be required to use the present invention as a model for the two cited references. However, it is well-known that an Examiner may not “use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Thus, Applicant thus submits that claim 1, and those depending therefrom, are in condition for allowance.

#### **Claims 7 and 8**

Claim 8 initially stands rejected as being indefinite due to use of trademarks in the claim. However, Applicant notes that “names used in trade are permissible in patent applications if: (A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim; or (B) In this country, their meanings are well-known and satisfactorily defined in the literature.” *See* M.P.E.P. § 608.01(v). Applicant submits that the definition provided on page 7 of the specification defines the products such that it is definite to be a part of the claim, and therefore this claim is not indefinite.

Claims 7 and 8 further stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the previously applied prior art in view of *Pelton* and *Hardy*. As the Examiner noted, *Hardy* teaches a gel with glycol inside a tube or package for wound treatment. That is, *Hardy* describes the use of this gel composition as a topical treatment for wounds, not as a substance for retaining either heat or cold temperatures within a massaging device. As *Hardy* fails to teach

such an application or suggest such an application, the only possible way to determine its application in a massaging device is to use the present application as a guide for such application. However, as Applicant previously noted, the Examiner may not "use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Thus, Applicant submits that claims 7 and 8 are in condition for allowance.

Finally, Applicant has added new claim 10, which further defines the massaging device of the present invention as having protuberances surrounding the outer shell, as shown in Figures 2-5. Applicant submits that none of the references cited by the Examiner illustrate a massaging device having this further limitation.

### **Conclusion**

In view of the Applicant's remarks provided above, Applicant respectfully submits that claims 1, 2, 4-8, and 10 are in condition for allowance. Accordingly, Applicant respectfully requests that the Examiner withdraw the previous rejections and that Notice of Allowability be issued.

Respectfully submitted,



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